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EXAMINER

DICKERSON, CHAD S

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 5/28/2010 have been fully considered but they are not persuasive. In the arguments filed, the Applicant argued that the Examiner failed to identify required reasoning from the base reference that would prompt the combination of the inventions of Murren and Marks. When viewing MPEP 2144 (I), the Examiner interprets this as the rationale in combining prior art can come from the prior art itself, explicitly or implicitly, generally available knowledge of one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. The prior art can be either the base or secondary reference, but in this case, since the feature of multi-casting is introduced by Marks, the Marks reference contains the reasoning as to the need for the combination (e.g. in order to offer the multicasting technique to a Unicast communication environment for improving the efficiency of transmission of documents within the Murren reference limited to a conventional communication system, with the motivation mentioned in paragraphs [0003]-[0007] of Marks). Moreover, regarding the mention of Applicant's disclosed multicasting method, the Examiner believes that the applied references read on the claimed invention. Therefore, the Examiner maintains the rationale of the combination in view of the secondary reference Marks.

Regarding the print-ready document argument, again the Examiner maintains the rejection of the claims in view of the above references and the background of Applicant's invention. Again, in the Murren reference, the invention discloses sending

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hard copy flyers to users who subscribe to such information in order to inform them about a product. With the combination of the background of Applicant's invention with the previous references, this creates a system that prevents the user from having to purchase or download different types of conversion or decomposition software for the document or constantly repeating conversion or decomposition (e.g. as seen in Applicant's specification in the background ¶ [005]) in order for a document to be printed by a user's printer immediately. Foregoing the need to acquire appropriate or updated drivers for conversion or repeat conversion or decomposition whenever the image data is transmitted to a printer saves the user time and prevents waste of printing resources. Therefore, in view of the above explanation with the combination of the above references, the rejection is maintained.

The Examiner would like to also address the comment of a teaching of bodily incorporation. MPEP 2145 states, "*The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art.*" *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). To the Examiner, the combination of the two references suggest that it would have been obvious to one of ordinary skill to incorporate a multicast communication procedure to modify a unicast system in order to produce an invention that allows for one sending terminal to send information simultaneously to multiple recipients for the efficient use of network resources¹. Moreover, with the

¹ See Marks '374 at ¶ [0003]-[0007].

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unicast system of Murren being modified by the Marks multicast communication protocol, it is expected that the multiple parties subscribing to the information within the Murren system would receive information from a source in a multicasting manner with a reasonable expectation that this communication method will be successful while being incorporated in Murren '085.

In response to the Applicant's argument regarding the asserted subscription/publication method in Marks, the Examiner would like to point out that the claim language indirectly referring to this method is performed by the Murren reference. The Murren reference discloses information published from a database and users entering in criteria to receive this published information if it fits within some criteria for a period of time². With the information published through the publication component and subscribed to by the users who want to subscribe to certain information on the database, it is clear that the Murren reference performs the publication/subscription method of Applicant's invention.

Therefore, with the above explanation, the rejection of the claims is maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAD DICKERSON whose telephone number is (571)270-1351. The examiner can normally be reached on 9:30-6:00pm Monday-Friday.

² See Murren '085 at ¶ [0002]-[0022].

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Haskins can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CHAD DICKERSON
Examiner
Art Unit 2625

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625